

### Remarks

The present Amendment is being filed within *two* months of the final Office Action dated April 4, 2006. Claims 1-21 are currently pending in the present application, and each of claims 1, 3, 13, 15 and 21 have been amended herein.

Applicant first wishes to thank the Examiner for the telephone conference that took place on May 26, 2006 between Examiner Vrettakos and Melissa Szanto, applicant's attorney. During this conference claim 1 was discussed with reference to Figures 4a and 4b of the application. It was pointed out that in these figures, element 40 denotes the active electrode, element 44 denotes the return electrode, and element 42 denotes a converting element having a conductive portion 54, where the converting element is slidable between the first extended position shown in Fig. 4a, and the second retracted position shown in Fig. 4b. In the first position, the conductive portion of the converting element is in electrical contact with and forms part of the active electrode and not the return electrode, whereas in the second position the conductive portion is *not* in electrical contact with, and does not form part of, the active electrode. Thus, in the first position the effective surface area of the active electrode is greater relative to the surface area of the return electrode than it is in the second position. The advantage of this feature was also pointed out to the Examiner, that being it allows for greater current densities at the active electrode when in the second position due to the smaller relative size of the active electrode (i.e., high enough current densities to achieve vaporization), and lesser current densities at the active electrode when in the first position (i.e., lower current densities as needed for coagulation of tissue) due to the larger surface area of the active electrode in this position. The features described above are explained in detail in the specification on Page 10, line 13 through Page 12, line 1.

Referring now to the claims, independent claim 1 has been amended to recite a converting element that is "slidably" movable between a first "extended" position and a second "retracted" position, as was also discussed with the Examiner on the May 26<sup>th</sup> teleconference. In view of the foregoing, applicant believes that claim 1, as currently written including the amendments described above, clearly point outs and distinctly claims the subject matter that the applicant regards as his invention in full compliance

with 35 U.S.C. § 112. As such, applicant respectfully requests that the rejection of claims 1-12 under 35 U.S.C. § 112 be withdrawn.

The Examiner has further rejected claims 1-6 and 9-21 under 35 U.S.C. § 102(b) as being unpatentable over U.S. Patent No. 5,472,442 to Klicek ("Klicek"), and claim 7 under 35 U.S.C. § 103 over Klicek in view of U.S. Patent No. 4,911,159 to Johnson et al. ("Johnson"). Applicant respectfully disagrees with these rejections.

As discussed during the May 26<sup>th</sup> teleconference, neither Klicek nor Johnson disclose an electrosurgical instrument having a converting element that is slidably movable between a first extended position and a second retracted position, wherein in the first position an electrically conductive portion of the converting element is in electrical contact with and forms part of the active electrode, and wherein in the second position it is not in electrical contact with and does not form part of the active electrode, thereby providing an instrument having a greater effective surface area of the active electrode in the first position as compared to the second position. This feature is recited in some fashion in each of amended independent claims 13, 15 and 21. Rather, both Klicek and Johnson merely disclose electrosurgical instruments that can merely switch between monopolar and bipolar operation.

Accordingly, applicant believes that each of pending independent claims 1, 13, 15 and 21, and all claims that depend therefrom, are patentable over the cited references and are in condition for allowance. Reconsideration and allowance of all pending claims is respectfully requested.

Applicants believe that no fee is due in connection with this response. The Commissioner is hereby authorized, however, to charge any additional fees that may be required to Account No. 10-0750/GYN-5004/MJS. This Authorization is being submitted in triplicate.

Respectfully submitted,

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